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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,018	08/27/2003	Hubert Kaffl	930008-2098.1	6469
20999	7590	06/06/2005	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			RAYFORD, SANDRA M	
			ART UNIT	PAPER NUMBER
			1772	

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding..

Office Action Summary

Application No.

10/650,018

Applicant(s)

KAFFL ET AL.

Examiner

Sandra M. Nolan-Rayford

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 15-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

Replacement Action

1. This office action replaces the action mailed on 25 May 2005 for this case.

Applicant's representative notified the examiner on 31 May 2005 that the claims were not correct in that office action.

Claims

2. After entry of the preliminary amendment of 27 August 2003 [as it is now recited in eDAN/IFW], claims 1-13 and 15-20 are pending.

Note: The eDAN/IFW file for this case, as it existed on 23 May 2005, displayed a preliminary amendment that recited only claims 1-8. That display has now been erased.

Summary of Base Claims

3. The base claims are claims 1, 12 and 15. They can be summarized as follows:

Claim 1 covers a packaging surface element that has a non-adhesive coating on at least part of its inner wall.

Claim 12 covers a packaged transdermal system (TDS) comprising:

- a TDS comprising a support layer, a matrix and a non-adhesive removeable cover layer with a sealable circumference,
 - a packaging surface element (PSE) having a non-adhesive coating on its inner wall and a sealable circumference,
- with the TDS and the PSE sealed at their circumferences.

Claim 15 covers a packaging TDS comprising a support layer, a matrix and a removeable cover layer, wherein the cover layer is non-adhesive, extends around the matrix such that it can be folded so that one "wing" covers the matrix and the other covers the first wing and the cover layer is sealable at an edge.

[See notes below.]

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Interpretive Notes:

- a. The term "circumference" is deemed to mean outer edge only.
- b. The term "wing" is deemed to mean a tab.

Priority

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

5. The drawings dated 27 August 2003 are objected to as informal.

Also, the figure numbers on some of the drawings (4A, 4B, 5A and 5B) are not the same as the figure numbers on pages 8-9 of the specification (4a, 4b, 5a and 5a).

Please correct the drawings.

Specification

6. The disclosure is objected to because of the following informalities:

The listing on pages 14 and 15 is not necessary.

Appropriate correction is required.

Comment re: References

7. Some references used in this office action were cited in the 29 July 2004 office action made by Examiner Brian Egan. Also, all earlier-cited references are applicable.

Claim Objections

8. Claims 12-13 are objected to because of the following informalities: the phrase "sealed with each other" (in claim 12) should be "sealed to each other".

In claim 15, at line 4, "extent" is misspelled.

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Claims 15-16 are objected to because it is unclear how the covering layer can be non-adhesive (line 3 of claim 15) and sealable (line 7 of that claim) at the same time.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 15-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 recites the limitations "one wing" and "the other wing" in lines 4 and 5, respectively. There is insufficient antecedent basis for these limitations in the claim.

Please correct claim 15.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-4 are rejected under 35 U.S.C. 102(b) as anticipated by Bozich et al (US 5,333,439).

Bozich and its anticipation of the claims are discussed in section 4 of the 29 July 2004 office action.

Claim Rejections - 35 USC § 103

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13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

15. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bozich in view of DE-4006688 (abstract only).

Bozich is discussed above. It fails to teach a halogenated hydrocarbon polymer.

The German abstract is discussed in section 6 of the 29 July 2004 office action.

The examiner notes that the German abstract recites "fluorinated hydrocarbon" and not polymers of same.

It is well known in the art that fluorine is a halogen.

In the absence of convincing objective evidence to the contrary, it would have been obvious to one having ordinary skill in the art at time of the invention to employ polymers based on the fluorinated hydrocarbons of the German abstract as release agents in the coatings of the Bozich surface elements to facilitate release.

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It is deemed desirable to employ effective release agents in the making of packaging so that surfaces that are not to be adhered are not joined together.

16. Claims 6-11 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bozich in view of Spreche (US 6,361,212).

Bozich is discussed above. It fails to teach pressure/color markers on its surface elements.

Spreche is discussed in section 7 of the 29 July 2004 office action.

In the absence of convincing objective evidence to the contrary, it would have been obvious to one having ordinary skill in the art at time of the invention to employ Spreche's markings when applying the coatings of Bozich to surface elements in order to facilitate alignment of coated/uncoated areas during manufacture of the packaging.

It is deemed desirable to employ markings that facilitate the alignment of various parts of packaging during manufacture so that the appropriate parts of the packaging adhere to each other.

17. Claims 1, 12-13 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sessions (US 5,722,943).

Sessions teaches a wound dressing (abstract) having a cover sheet, a matrix and a carrier (abstract). The dressing has two overlapping tabs, or "wings" (see Figures 13 and 16; also col. 2, lines 21-54). The tabs are part of a two-tab system, described at col. 7, lines 40-61, including a film sheet **10**, a carrier sheet **8** and a release surface **9**.

It does not recite all of the features of recited in claims 1-13 and 15-20.

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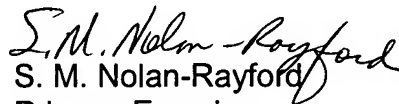
It would have been obvious to one having ordinary skill in the art at the time of the invention to position the release surface(s) in places where one did not adhere between sheets, in order to facilitate the making and use of the Sessions dressing.

Conclusion

Any inquiry concerning this communication should be addressed to Sandra M. Nolan-Rayford, at telephone number 571/272-1495. She can be reached Monday through Thursday, from 6:30 am to 4:00 pm, ET.

If attempts to reach the examiner are unsuccessful, contact her supervisor, Harold Pyon, at 571/272-1498.

The fax number for patent application documents is 703/872-9306.


S. M. Nolan-Rayford
Primary Examiner
Technology Center 1700

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